

REMARKS

Reconsideration of the present application as amended is respectfully requested.

In the Office action, the Examiner indicated that claim 3 would be allowable if amended to overcome objection to it as being dependent upon a rejected base claim and that claim 4 would be allowable if rewritten to overcome its rejection under 35 U.S.C. §112 and to include all of the limitations of the base claim and any intervening claims. Applicants gratefully acknowledge this indication of allowable subject matter. Accordingly, Applicants have cancelled claim 3 and added claim 7 to re-present claim 3 in independent form including all the limitations of the former base claim 1. Claim 4 has been amended to depend from new claim 7.

Claim 4 was rejected under 35 U.S.C. §112, second paragraph as not having antecedent basis for "the gold content" in line 2. Amending claim 4 to depend from new claim 7, which recites that the amalgam further comprises gold, is believed to overcome the rejection. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 1 has been amended by removing the reference numerals, to put claim 1 in better form. Also to present those

claims in better form, "characterized in that" has been changed to "wherein" in claims 1, 2 and 4.

In the Office action, the Examiner rejected claims 1, 2 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,972,118 (Yorifuji). Applicants respectfully traverse and request that the Examiner reconsider this rejection, for the reasons set forth here and in the Amendment filed in response to the Examiner's October 7, 2002 Office action. Even assuming, for the sake of argument, that Yorifuji could fairly be said to teach a range overlapping the range of mercury content recited in claim 1, to anticipate a claim, prior art must disclose a claimed range with sufficient specificity, MPEP §2131.03. Applicants respectfully submit the claimed range is not disclosed or suggested in Yorifuji with sufficient specificity, because, in particular, Yorifuji is directed only to a mercury content between 1 and 12 wt % (col. 3, lines 47-51).

New claims 8-13 have been added to clarify the present invention.

Claim 8 has been added to claim the amalgam of claim 7. Applicants respectfully submit that claim 8 is patentable for the same reasons as claim 7.

New independent claim 9 recites an amalgam with mercury

content between 0.05 and 1 at.%, and a coldest spot temperature in the range between 65°C and 165°C, which is disclosed in the specification at, for example, page 3 lines 23-34 to page 4, lines 1-6. Claim 10 recites a temperature of 120°C to 165°C as, for example, shown in Fig. 2 and disclosed in the specification of the present invention at page 8, lines 19-22. Claim 11 recites an amalgam with mercury content between 0.05 and 0.75 at.% (specification at page 4, lines 26-27). Claim 12 recites an amalgam temperature of 120 to 165°C as, in particular, disclosed in Fig. 2, as well as mercury content between 0.05 and 0.75 at.%. Claim 13 recites the nominal operation disclosed in the specification at page lines 24-27.

In stark contrast to new claims 9-13, Yorifugi teaches and suggests, in Fig. 1, Fig. 3, and at col. 2, lines 9-10, only an amalgam which controls mercury vapor pressure in a lamp which operates under a relatively low or medium range bulb surface temperature. A medium bulb surface temperature is 60°C or 70°C (col. 1, lines 16-17). Yorifugi thus does not disclose or suggest a coldest spot temperature between 65°C and 165°C as recited in claim 9 or between 120°C and 165°C as recited in claim 10 or an amalgam temperature between 120°C and 165°C as recited in claim 12 or between 65°C and 165°C as recited in claim

13.

In view of the above, it is respectfully submitted that claims 1, 2, 4 and 6-13 are patentable and that the present application is in condition for allowance. A Notice of Allowance is earnestly solicited.

If any informalities remain, the Examiner is requested to telephone the undersigned in order to expedite allowance.

Please charge any fee deficiencies and credit any overpayments to Deposit Account No. 14-1270.

Respectfully submitted,

By Frank Keegan
Frank Keegan, Reg. 50,145
Attorney
(914) 333-9669
June 24, 2003